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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,587	11/21/2000	Michael F. Braitberg	M-8531-ID US	9943

7590 04/26/2004  
MacPherson Kwok Chen & Heid LLP  
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Suite 226  
San Jose, CA 95110

EXAMINER

CHAI, LONGBIT

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/721,587

Applicant(s)

BRAITBERG ET AL.

Examiner

Longbit Chai

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 - 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: Page 1, Paragraph 1 indicates "Cross reference is made to U.S. Patent Application Serial No. 09/315,398 of Braitberg, et. Al., filed May 20, 1996". The filing data should be May 20, 1999 instead of 1996.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 11 and 12 recites the limitation "said recordable area" in claim 11 line 4 and claim 12 line 3. There is insufficient antecedent basis for this limitation in the claim. See MPEP § 2173.05 (e).

3. Claim 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim language "some of" (claim 11 line 6; claim 12, line 6) used renders the claims indefinite because the claims do not set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gotoh (U.S. Patent Number 6052465), hereinafter referred to as Gotoh.

5. As per claim 11 and 12, Gotoh teaches:

a. providing a data recording medium having a first mastered content and a second writable area (Gotoh: Column 1 Line 45 – 46 and Column 1 Line 27 – 38).

b. recording at least first license information in said recordable area (Gotoh: Column 1 Line 43 – 46 and Column 5 Line 66 – 67: Gotoh teaches writing the barcode information and does not expressly teach writing the license information into the writable area.

However, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify the barcode to accommodate the license information).

c. comparing said license information to license criteria (Gotoh: Column 31 Line 36 – 66 and Column 32 Line 5 – 9: Gotoh teaches comparison criteria to access the mastered data before reproducing the copy through the network protection or Internet. Gotoh does not expressly teach the comparing criteria based on the license information. However, it would have been obvious to the person of ordinary skill in the art at the time the invention was made to modify barcode criteria to accommodate license criteria

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because the criteria being exercised to access the mastered data before reproducing the copy is essentially product-dependent.); and

d. permitting access to at least said mastered material on the basis of said comparing step (Gotoh: Column 4 Line 45 – 48: reproducing implies the access to the mastered material first).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. See MPEP § 1302.04 (b).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Kawamura (U.S. Patent Number 5812519) discloses "ROM-RAM Disk".
- b. Braiterberg (U.S. Patent No. 6580683) discloses "Optical Recording Medium Having a Master Data Area and a Writable Data Area".
- c. Itami (U.S. Patent No. 5684785) discloses "Optical Disk and Method of Preventing Fraudulent Use of Optical Disk Rotation Synchronous Control System".
- d. Schneck (U.S. Patent Number 6314409) discloses "System for Controlling access and Distribution of Digital Property".

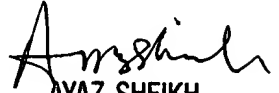
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 703-305-0710. The examiner can normally be reached on Monday-Friday 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Longbit Chai  
Examiner  
Art Unit 2131

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